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09/863,616	05/23/2001	Yasushi Kasajima	125A 3124	8821

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EXAMINER

COFFY, EMMANUEL

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 04/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/863,616

Applicant(s)

KASAJIMA, YASUSHI

Examiner

Emmanuel Coffy

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Decmeber 9, 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. This action is responsive to the amendment filed on December 9, 2004. Claims 1, 2, 4, 6, 9, 10, 11, 12, 13, 14 and 15 are amended. Claims 1-15 are pending and represent a method, system "For Automatically Transferring Electronic Mail over A Communication Network, Communication Server Apparatus, Automatic Transfer And Intermediary Communication Server Apparatus And Communication Server Apparatus For Information Service."

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: "Method and System For Automatically Transfer Electronic Mail over A Communication Network." See MPEP §606.01.

3. Claims 9, 10, 12, 13 and 14 were objected to due to minor informalities and applicant has indicated that these claims were amended to correct these informalities. However, upon a review of the claims, the informalities were not removed in claims 13 and 14. Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claim 14 is rejected.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 14 is rejected under 35 U.S.C. §112 ¶2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention due to ambiguous language. A reasonable artisan skilled in the art could not comprehend the claims as written. The claims recite: "...and the like..."

The phrase "and the like" renders the claim indefinite because the claim includes elements not actually disclosed (those encompassed by "and the like"), thereby rendering the scope of the claim unascertainable. See MPEP § 2173.05(d). This is applicable to all other claims where the phrase "and the like" is found. Furthermore, every claim which claims dependency on a claim rejected under this paragraph is rejected by virtue of said dependency.

Response to Arguments

5. In the remarks, applicant compares and contrasts the cited prior art to the invention at bar resulting in what applicant believes to be the distinguishing feature of the invention. Applicant asserted said feature as follows: "the invention provides for a transfer trigger condition which is included in the mail to be transferred so that a sender who writes a mail can provide a transferred trigger condition." Applicant then contrasted the teachings of the prior art without providing any line or column citations as: "a user who will be a receiver of the mail provides a transfer condition and command." (applicant's remarks, page 7 and 8.)

The Examiner disagrees that there is any difference between the prior art and the invention, because the construct of the phrase "a user who will be a receiver of the mail provides a transfer condition and command" obviates the fact that a user who will be a

receiver is actually a sender. In this instance, the user is both the sender and receiver. Therefore, the prior art reads on the claim and the rejection is maintained.

6. In reply to an obviousness rejection under 35 U.S.C. § 103, applicant next argued that in the secondary reference the placing of an outer wrapper (identification code) and providing the address information on the mobile device only occurs when the email is being redirected. (applicant's remarks, page 9.)

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Furthermore, in response to applicant's arguments against the reference individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

7. Applicant's arguments have thus been fully considered but they are not persuasive. In response to Applicant's arguments, 37 CFR § 1.111(c) requires applicant

to "clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made.

8. The claims stand rejected as articulated in the First Office Action (see below) and all objections not addressed in Applicant's response are herein reiterated.

Claim Rejections - 35 USC § 102

The following is a quotation of the second paragraph of 35 U.S.C. 102:

A person shall be entitled to a patent unless-

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claim 1 directed to a method is rejected under 35 USC 102(e) as being clearly anticipated by Moon et al. (US 6,138,146).

Moon teaches a mail forwarding system having a server, a fixed computer and a router for connection to a public network external to a private network, all interconnected via a data connection, with the server controlling electronic mail resources addressed to a user of the fixed computer received by the private network. (See abstract).

Claim 1:

Referring to claim 1, Moon teaches the invention as claimed including a method for automatically transferring an electronic mail over a communication network, said method comprising the steps of: (See Fig. 1 and Fig. 7).

sending from a communication terminal unit, an electronic mail message together with a transfer trigger condition, which is made according to predetermined rules specified by event information, to a communication server apparatus equipped on said communication network, (See col. 6, lines 3-25).

receiving and registering at said communication server apparatus said electronic mail together with said transfer trigger condition, and (See col. 6, lines 3-10 and Fig. 7 (48)).

watching at said communication server apparatus said transfer trigger condition after registration of said electronic mail message whether or not said condition meets a predetermined condition and automatically transferring the corresponding electronic mail message to a communication terminal unit to be transferred when detecting said transfer condition meets said predetermined condition. (See col. 2 lines 30-33 and col. 6, lines 20-25).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2-15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Moon et.al. (US '146) in view of Lazaridis et al. (US 6,219,694.)

Claim 2:

Referring to claim 2, Moon substantially teaches the invention including a method for automatically transferring an electronic mail over a communication network, said method comprising the steps of:

sending from a communication terminal unit an electronic mail message together with a transfer trigger condition, which is made according to predetermined rules specified by event information, to an automatic transfer and intermediary communication server apparatus equipped on said communication network, (See col. 6, lines 3-25).

receiving and registering at said automatic transfer and intermediary communication server said electronic mail message and allocating an individual identification code to said registered electronic message and thereafter sending said transfer trigger condition corresponding to registered electronic mail message together with said allocated identification code to the predetermined destination communication terminal unit, said identification code being allocated to said respective electronic mail message registered at said automatic transfer and intermediary communication server, (See col. 6, lines 3-10).

watching at said destination communication terminal unit whether or not said transfer trigger condition received meets a predetermined condition and sending to said automatic transfer and intermediary communication server automatic transfer command together with said identification code corresponding to said electronic mail message of

which transfer trigger condition meets when said transfer trigger condition meets the predetermined condition, and

automatically transferring from said transfer and intermediary communication server apparatus the corresponding registered electronic mail specified by said identification code sent from said destination communication terminal unit to a communication terminal unit to be transferred, on receiving said automatic transfer command from said destination communication terminal unit. (See col. 2 lines 30-33 and col. 6, lines 20-25).

Moon teaches a mail forwarding system having a server, a fixed computer and a router for connection to a public network external to a private network, all interconnected via a data connection, with the server controlling electronic mail resources addressed to a user of the fixed computer received by the private network. (See abstract). Moon does not specifically teach allocating an individual identification code to said registered electronic message and thereafter sending said transfer trigger condition corresponding to registered electronic mail message together with said allocated identification code to the predetermined destination communication terminal unit. However, Lazaridis teaches placing an outer wrapper (Identification) about the original message and by providing the addressing information of the communication terminal unit to be transferred. (See col. 10, line 66-col. 11, line 5).

Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the electronic mail forwarding system taught by Moon with the allocation of individual identification code disclosed by Lazaridis. Such a system

would allow a user to forward messages to different classes or types of equipment.

Therefore, claim 2 is rejected.

Claim 3:

Referring to claim 3, Moon substantially teaches the invention as claimed including the method of claim 1 or 2, wherein said transfer trigger condition contains information on the operation of a facility or equipment to be notified to said communication server apparatus as said event information.

Moon teaches a mail forwarding system having a server, a fixed computer and a router for connection to a public network external to a private network. (See abstract). Moon does not specifically teach trigger condition that contains information on the operation of a facility or equipment to be notified by said communication server apparatus as said event information.

However, Lazaridis teaches the detection of redirection event (See col. 4, line 19-24) to push certain user-selected data items such as attachments (See col. 6, lines 61-64 and col. 3, lines 50-56).

Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the electronic mail forwarding system taught by Moon with the detection of redirection event disclosed by Lazaridis. Such a system would allow a user to forward users' manuals and other manuals to different classes or types of equipment. Therefore, claim 3 is rejected.

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Claim 4:

Referring to claim 4, Moon substantially teaches the invention as claimed including the method of claim 1 or 2, wherein said transfer trigger condition contains as said event information, command information or information on location of specific terminals both sent from a service server apparatus or communication terminal unit, each of which is two-way communicable with said communication server apparatus on a communication network.

Moon teaches a mail forwarding system having a server, a fixed computer and a router for connection to a public network external to a private network. (See abstract). Moon does not specifically teach information on location of specific terminals sent from a service server apparatus or communication terminal unit, each of which is two-way communicable with the communication server apparatus on a communication network.

However, Lazaridis teaches information on location of specific terminals (See col. 7, line 16-19) sent from a service server apparatus or communication terminal unit, each of which is two-way communicable with the communication server apparatus on a communication network. (See col. 6, lines 37-48).

Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the electronic mail forwarding system taught by Moon with two-way communication of specific terminal's location disclosed by Lazaridis. Such a system would allow a user to replicate user-selected data items from the server to a mobile device. Therefore, claim 4 is rejected.

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Claim 5:

Referring to claim 5, Moon substantially teaches the invention as claimed including the method of claim 1 or 2, wherein said transfer trigger condition is added an expiry date of automatic transferring for said registered electronic mail message.

Moon teaches a mail-forwarding program which includes a timing routine. (See col. 6, lines 16-25 and col.6, line 63-col. 7, line 5). Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to use the electronic mail forwarding system which includes a timing routine as taught by Moon. Therefore, claim 5 is rejected.

Claim 6:

Referring to claim 6, Moon substantially teaches the invention as claimed including the method of claim 1 or 2, wherein said electronic mail of which expiry date for automatic transferring has expired is transferred to a communication terminal unit to be transferred or is erased, when the corresponding expiry date set in said transfer trigger condition expires.

Moon teaches a mail-forwarding program which includes a timing routine. (See col. 6, lines 16-25 and col.6, line 63-col. 7, line 20). Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to use the electronic mail forwarding system which includes a timing routine as taught by Moon. Therefore, claim 6 is rejected.

Claim 7:

Referring to claim 7, Moon substantially teaches the invention as claimed including the method of claim 1 or 2, wherein said communication server apparatus sends a transfer completion notice to the communication terminal unit of the sender after completing transfer of the corresponding electronic mail message according to said transfer trigger condition.

Moon teaches a mail-forwarding program which includes transmission of a notification signal. (See col. 7, lines 39-63). Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to use the electronic mail forwarding system which includes transmission of a notification signal as taught by Moon. Therefore, claim 7 is rejected.

Claim 8:

Referring to claim 8, Moon substantially teaches the invention as claimed including the method of claim 1 or 2, wherein said communication server apparatus sends a transfer failure notice to the communication terminal unit of the sender when having fail to transfer the corresponding electronic mail message according to said transfer trigger condition.

Moon teaches a mail-forwarding program which includes transmission of a notification signal. (See col. 7, lines 39-63). Moon does not specifically teach a transfer failure notice. However, Lazaridis teaches setting a trigger flag if a received message or signal is a trigger event or not.

Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the electronic mail forwarding system which includes transmission of a notification signal taught by Moon with the flag setting event as disclosed by Lazaridis. Such a system would allow a user to be cognizant of a system failure. Therefore, claim 8 is rejected.

Claim 11:

Referring to claim 11, Moon substantially teaches the invention as claimed including the system of claim 9 or 10, wherein a media file where at least either one of audio information, image information and the like is stored is attached to said electronic mail message, wherein said communication terminals unit to be transferred said electronic mail message is such one as TV set or telephone set connected to an indoor information network system, and wherein said communication server apparatus automatically opens said media file to out put the contents of said media file into said communication terminals, when transferring said electronic mail message according to said transfer trigger condition.

Moon teaches a mail forwarding system having a server, a fixed computer and a router for connection to a public network external to a private network. (See abstract). Moon does not specifically teach media file transferred to communication terminals such as TV set or telephone set connected to an indoor information network system, and wherein said communication server apparatus automatically opens said media file to out put the contents of said media file into said communication terminals, when transferring said electronic mail message according to said transfer trigger condition.

However, Lazaridis teaches media file (See col. 6, line 21-22) transferred to communication terminals such as TV set or telephone set connected to an indoor information network system, and wherein said communication server apparatus automatically opens said media file to out put the contents of said media file into said communication terminals, when transferring said electronic mail message according to said transfer trigger condition. (See col. 6, lines 10-15, 31-36; col. 8, lines 56-65).

Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the electronic mail forwarding system taught by Moon with transfer of media file as disclosed by Lazaridis. Such a system is a more automated system allowing the user to control both the server and the receiving device. Therefore, claim 11 is rejected.

Claim 15:

Referring to claim 15, Moon substantially teaches the invention as claimed including a communication server apparatus for information service equipped on a communication network having a specific template to fill transfer trigger condition according to a predetermined rule specified by event information therein, said communication network enabling a communication terminal unit accessing thereto to download said template over a communication network.

Moon teaches a mail forwarding system having a server, a fixed computer and a router for connection to a public network external to a private network. (See abstract). Moon does not specifically teach specific template to fill transfer trigger condition according to a predetermined rule specified by event information therein. However,

Lazaridis teaches configuring and setting-up the user-defined event trigger points; (See col. 10, line 40-45) whereby a communication terminal unit can access the network to download said template over a communication network.(See col. 6, line 56-col. 7, line 7; col. 9, lines 51-64).

Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the electronic mail forwarding system taught by Moon with the downloading and configuration user-defined event trigger points capabilities as disclosed by Lazaridis. Such a system would afford the user more flexibility than other available systems. Therefore, claim 15 is rejected.

Claims 9-10, 12-14:

These claims are not specifically addressed because they fail to teach or define any significantly new limitation above and beyond claims 1-8 and 11 to warrant particular treatment, and therefore are rejected for similar reasons.

Conclusion

11. THIS ACTION IS MADE FINAL.

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and

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any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emmanuel Coffy whose telephone number is (571) 272-3997. The examiner can normally be reached on 8:30 - 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Emmanuel Coffy
Patent Examiner
Art Unit 2157

***EC
April 5, 2005


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